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EXAMINER

BROCKETTI, JULIE K

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,165

Applicant(s)

HARMON, MATTHEW COLE

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.84(n) and 1.81(o). 1.84(n) states:

*Symbols.* Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols, which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols, which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols and if they are readily identifiable.

1.81(o) states:

(o) *Legends.* Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

The drawings cannot consist solely of boxes and reference numbers. The boxes must be labeled as to what they are and/or redrawn to represent the real shape of the object they are intended to represent. The drawings as now presented, tell nothing about the invention, they merely consist of stick figures and boxes. Correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the game account and its contents must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "500" has been used to designate both the Internet and the World Wide Web. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by

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the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

A substitute specification including all section headings is required pursuant to 37 CFR 1.125(a) because due to the vast amendments to the specification, it is confusing as to what paragraphs go under what subject headings and the specification is difficult to read due to the number of insertions and deletions.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

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The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The amendment filed July 13, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

1. "The Platform is a "virtual storage" and/or "virtual safe deposit box". The original specification does not mention "virtual" elements.
2. "The PLATFORM offers the user the opportunity to re-enter a game by logging-in to their existing account..." The original specification does not mention logging-in to an account.
3. "The PLATFORM provides memory and storage..." The original specification does not mention memory or storage.
4. "The E-Commerce Role Playing Platform concepts runs solely via the World Wide Web". The original specification mentions only the Internet not the WWW, they are to different things.
5. "The game" has replaced "the licensing company" in many parts of the specification. A game is not the same thing as a licensing company. Therefore, having the game now conduct the acts that were performed by a licensing company in the original specification is improper.
6. "This is a major change over current art as a User 10 is using real currency". Nowhere in the original specification does it state that a user is playing the game with "real currency" meaning actual U.S. dollars, etc.

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because of the following informalities:

1. In the sentence, "To provide the user "place" to return to..." The word "a" should be inserted before the word "place" in order to be grammatically correct.

2. Under the Brief Descriptions of Drawing Section: the statement of what Figure 1 shows tells nothing of what the picture involves, just that it is the invention. It should describe what the invention is or what the picture shows, i.e. a game with multiple players, etc.

3. Under Summary the sentence "The current invention is an E-Commerce Role Playing Platform is a fairly..." should have the second "is" deleted and a comma inserted before the word "a".

4. Under Objects and Advantages, in the sentence "Additional objects and advantages are, a having Platform

5. In the sentence "As shown in Figure 1, the current invention is an E-Commerce Role Playing Platform is a fairly simple..." The second "is" should be deleted and a comma inserted before the word "a".

Appropriate correction is required.

### ***Claim Objections***



Claim 10 is objected to because of the following informalities: the word "opponents" game account should be "opponent's". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 2 states "memory means". Nowhere in the original specification does it state that memory is used.

Claim 6 states, "...where said game account can be used to purchase additional levels." The original specification actually states the opposite of this claim in that the game account cannot be used to purchase additional game levels.

Claims 10 and 11 refer to "currency". No where in the original specification does it state that "currency" is used throughout game play it

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merely states "gold" (money) this is not the same as currency as applicant now wants to claim.

Claim 13 states, "...where said game account is funded through cash". The original specification states "Internet dollars" not cash, these are two different things.

Claim 14 states, "...where said game account is funded through a check". The original specification states "e-check". An e-check is different from a check.

Claim 15 states, "...where said game verifies a player's age". The original specification states that the licensing company, not the game, verified the player's age.

Claims 2-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 2 states, "...that the game is run on a computer where said players are connected to the game through a connection to the Internet and where each player has a game account that is stored in a memory means..." How are the players connected to the Internet, through their own computers or a main computer? Where is the memory means and how does it store the data?

Claims 4-8 recite purchasing various items. How are these items purchased, is a single transmitted between two computers, is it automatic, does the player initiate the transaction?

Claim 11 states that the currency goes to the player's game account. How does it "go" to the player's account? Is it transmitted and what does the transmitting?

Claims 12-14 recite funding the account through various methods. How is the account funded? For example, if it is funded through cash, does the player insert cash somewhere on the computer, or if it is funded through check, does the player mail the check somewhere?

Claim 15 states that the game verifies the player's age. How is this done? Does the game check a birth certificate or just ask a player their age? What steps are performed for this to occur?

The claims are replete with limitations that would cause someone with ordinary skill in the art to perform experimentation to implement the game as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the word "means" is preceded by the word(s) "memory" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim 2 states, "...where a plurality of players can play..." Where is this place that all these players can play?

Claim 3 states "...transactions." What are these transactions?

Claim 4 states "...purchase additional items". What items does a player already have? What are the additional items they wish to purchase?

Claim 5 states "...purchase additional skills". What are these skills?

Claim 6 states "...purchase additional levels". What are these levels, are they level 1, 2, 3, etc. or are they something else?

Claim 7 states "... purchase special skills". What makes a skill "special" what are the "special skills"?

Claim 9 states "...additional characteristics". What are these characteristics? Are they facial features, abilities, skills, career?

Claim 16 states "...said player will be camped on a daily basis with maximum protection". What is "camping"? It is unclear as to what this phrase is referring to.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites "a role playing strategy computer game". A game by itself is not statutory and the claims as written are merely descriptive material. Is Applicant's invention a method of playing a game, software for playing a game recorded on a tangible medium or a gaming apparatus or system?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 2-16 are rejected under 35 U.S.C. 102(a) as being anticipated by "Ultima Online". "Ultima Online" is a role-playing strategy computer game. It is a multi-user game where a player plays as a role playing character where a plurality of players can play, where said game is run on a computer where said players are connected to the game through a connection to the Internet where

each player has a game account that is stored in a memory means and the game account is funded with currency (See Ultima Online Manual pg. 12-13, 39, "Beginning Britannia") [claim 2]. For example, to establish a game account players must pay money, i.e. currency, to "fund" their account with a beginning amount of gold. The game also has character "accounts" where the characters can spend or earn money. The game account stores a history of events, game play tactics; win record and transactions (See Ultima Online pg. 48) [claim 3]. The game account can be used to purchase additional items, skills, levels, special skills and lives (See Ultima Online pg. 64) [claims 4-8]. For example, a player may purchase a house, or training to gain skills/special skills, a player may also create up to 5 characters, i.e. additional lives or a player may pay money to play as an advanced character (See Ultima Online & Advanced Character Service). When a player beats an opponent the player takes over any additional characteristics that his opponent has gained (See Ultima Online pg. 76-81, 89) [claim 9]. For example, a player may gain skills by attacking another player or a player can steal from a player they have attacked thereby gaining characteristics. The player receives currency from his defeated opponents game account (See Ultima Online) [claim 10]. The currency goes to the player's game account (See Ultima Online pg. 39) [claim 11]. For example, if you rob your opponent, the money you steal comes from his game account also if you sell something to an opponent, that money goes from the opponent's account into the player's account. The game also verifies a player's age (See

Ultima Online pg. 12) [claim 15]. When the player is offline, for a minimum fee that player will be camped on a daily basis with maximum protection (See Ultima Online pg. 47) [claim 16]. For example, when a player is not playing the game, their character remains is camped. The game account is funded through a credit card or check (See Ultima Online "Description of Service & Fees").

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ultima Online". "Ultima Online" does not expressly disclose funding the account with cash. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use either cash because Applicant has not disclosed that any of these payment methods provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any of the payment methods because the ultimate goal is to pay for the subscription to the game.

Therefore, it would have been an obvious matter of design choice to modify Ultima Online to obtain the invention specified in claim 13.

### ***Response to Arguments***

Applicant's arguments filed July 13, 2004 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 703-308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julie K Brockett  
Examiner  
Art Unit 3713